

REMARKS

Claims 1-32 are pending. Claims 1-3, 5, and 26-32 are rejected. Claims 4 and 6-25 are objected to. Without acquiescing in any of the stated grounds of rejection, but solely to expedite prosecution of this application, claim 1 is amended herein to positively recite steps of the claimed method; claims 2 and 26-30 are cancelled without prejudice; and claims 4 and 6 are rewritten in independent form to incorporate the limitations of the claims from which they depended. It is respectfully submitted that these amendments are sufficient to place the application in condition for allowance.

The various grounds of rejection will be discussed in turn.

35 U.S.C. § 112

Claims 2 and 26-30 stand rejected under various grounds under 35 U.S.C. § 112. Without acquiescing in the stated grounds of the rejections, those claims are cancelled herein without prejudice, the applicants reserving all rights to pursue such claims in one or more continuing or divisional applications. It is respectfully submitted that the stated grounds of rejection are now rendered moot, and it is requested that these rejections be withdrawn.

35 U.S.C. § 102

The rejection of claim 1 as allegedly anticipated by Peng et al. is respectfully traversed. In the Office action at page 8, the Examiner noted that the language “method for identifying a candidate branching morphogenesis modulating agent” and “wherein a difference between the test agent-biased activity and the reference activity identifies the test agent as a candidate branching morphogenesis modulating agent” were not given patentable weight. Claim 1 has been amended to specifically recite an affirmative step of comparing the test agent based activity and the reference activity to determine whether the test agent is a candidate branching morphogenesis modulating agent. It is respectfully submitted that this affirmative step is not disclosed in the Peng et al. reference, such that this rejection has been overcome.

It is respectfully submitted that this amendment also is sufficient to overcome the rejections of claims 1 and 5 as allegedly anticipated by Petersen et al., of claims 1 and 3 as allegedly anticipated by Takeishi et al., and of claim 1 as allegedly anticipated by Lee et al. The

Examiner's comment at page 11 of the Action that certain steps were not given patentable weight because they "indicate only abstract thought rather than an active method step" is respectfully traversed. As recently stated by the Court of Appeals for the Federal circuit, "[i]t is irrelevant that any individual step or limitation of such processes by itself would be unpatentable under §101." *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385, 1394, *See In re Alappat*, 33 F.3d 1526, 1543-44, 31 USPQ2d 1545 (Fed. Cir. 1994) (en banc) (citing *Diehr*, 450 U.S. at 187). Rather, it is the claim as a whole that must be evaluated. It is therefore respectfully requested that these claims be reconsidered and that all the steps thereof be given patentable weight. It is respectfully considered that claim 1 is patentable, and claims 3 and 5 are patentable as depending from a patentable base claim.

The rejection of claims 31 and 32 is respectfully traversed. In the rejection, the Examiner noted that the phrase "method of diagnosing a disease in a patient" has not been given patentable weight because it is in the preamble. Without acquiescing in that ground of rejection, claim 31 has been rewritten to repeat that limitation in the body of the claim. In addition claim 31 has been amended to recite the specific MBM polypeptides to which the probe can bind. It is respectfully submitted that these amendments are sufficient to overcome the rejection of claim 31. Claim 32 is patentable as depending from an allowable base claim.

Claim Objections

Claims 4 and 6 have been rewritten in independent form, and incorporate the elected species. It is respectfully submitted that these amendments are sufficient to overcome the rejections of these claims and all claims that depend therefrom.

CONCLUSION

It is respectfully submitted that the claims are in condition for allowance, and a Notice of Allowance is respectfully requested.

If the Examiner believes that a telephone or personal interview would expedite prosecution of the instant application, the Examiner is respectfully invited to call the undersigned representative at (312) 913-0001.

Respectfully submitted,
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